

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1-6 will have been canceled and new claims 7-12 will have been submitted for consideration by the Examiner.

In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicant's claim for priority under 35 U.S.C. §119 and receipt of the certified copy of the priority document in the Official Action. Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on April 1, 2002 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements. In this regard, Applicant notes that the Examiner inadvertently indicated the Information Disclosure Statement had been filed on January 3, 2004 when it had actually been filed on April 1, 2002.

Turning to the merits of the action, the Examiner has rejected claims 1-2 and 5 under 35 U.S.C § 103 (a) as being unpatentable over TADA (U.S. Patent No. 6,237,040) in view of BEER et al. (U.S. Patent No. 5,864,676). The Examiner also has rejected claims 3-4 and 6 under 35 U.S.C § 103 (a) as being

unpatentable over TADA in view of an article by MOCKAPETRIS (RFC 1034-Domain names-concepts and facilities, November 1987). Applicant respectfully traverses both grounds of rejection.

As noted above, Applicant has canceled claims 1-6 and has submitted new claims 7-12 for the Examiner's consideration. Applicant respectfully traverses the above rejections based on newly added claims 7-12, and will discuss the rejections with respect to the pending claims in the present application, as will be set forth hereinbelow. The newly added claims clarify the subject matter recited in the canceled claims, but do not narrow the scope of the claims.

Applicant's invention, as defined by the claims, generally relate to a communication control apparatus which comprises a first communicator configured to be connected to a network, and a second communicator configured to be connected to an Internet facsimile apparatus. The Internet facsimile apparatus scans image data and transmits to a recipient, via the communication control apparatus, an e-mail to which the scanned image data is attached. The communication control apparatus further comprises a controller which receives from the Internet facsimile apparatus, via the second communicator, an e-mail address of the recipient according to a SMTP protocol, converts the received e-mail address of the recipient into URL data, receives, from the receiving Internet facsimile apparatus via the second communicator, e-mail data directed to the recipient according to the SMTP protocol, converts the received e-mail data into HTML data, and transmits to the recipient, via the first

communicator, the converted HTML data, based on the converted URL data, according to a HTTP protocol. Claims 11-12 recite related methods.

With respect to the rejection of claims 1-2 and 5 under 35 U.S.C. § 103(a), Applicant submits that TADA relates to a method and apparatus for processing e-mail with only a WWW browser. In TADA, the user terminal apparatus 14 transmits a WWW service request to Internet service provider 12 (col.5, lines 59-63 and Fig.8, S201). The Internet service provider 12 transmits a request for e-mail service to the user's e-mail service provider apparatus 16 (col.6, lines 5-9 and Fig.8, S205). The Internet service provider 12 receives, from the user's e-mail service provider apparatus 16, e-mail addressed to the user (col.6, lines 10-12 and Fig.8, S207). The Internet service provider 12 converts the user's e-mail into HTML data (col.6, lines 12-13 and Fig.8, 208). The user terminal apparatus 14 transmits, to WWW-added service provider apparatus 43, which is included in the Internet service provider 12, a request for an e-mail HTML file (col.6, lines 33-38 and Fig.10, S401). The WWW-added service provider apparatus 43 returns the requested user e-mail HTML file to the user terminal apparatus 14 (col.6, lines 38-42 and Fig.10, S402).

However, Applicant submits that TADA does not disclose a communicator which is connected to an Internet facsimile apparatus, since the user's e-mail service provider apparatus 16, which transmits e-mail to the Internet service provider 12, is not an Internet facsimile apparatus. Nor does TADA suggest this feature.

As the Examiner admitted in the outstanding Official Action mailed on March 14, 2005, TADA also does not disclose a controller which receives, from the Internet facsimile apparatus via the second communicator, an e-mail address of the recipient according to a SMTP protocol and converts the received e-mail address of the recipient into URL data.

Further, Applicant submits that, in TADA, the Internet service provider 12 returns an e-mail HTML file to the user terminal apparatus 14, in response to a request for the e-mail HTML file from the user terminal apparatus 14 (col.6, lines 35-41). Thus, in TADA, the Internet service provider 12 does not receive, from the user's e-mail service provider apparatus 16, which transmits e-mail to the Internet service provider 12, an e-mail address of the user terminal apparatus 14, since the Internet service provider 12 returns the e-mail HTML file to the user terminal apparatus 14, in response to the request from the user terminal apparatus 14 (col.6, lines 35-41). Therefore, Applicant submits that an additional basis exists for concluding that TADA does not disclose or suggest a controller which receives, from the Internet facsimile apparatus via the second communicator, an e-mail address of the recipient according to a SMTP protocol and converts the received e-mail address of the recipient into URL data.

Applicant additionally submits that BEER et al. fail to disclose that which is lacking in TADA. BEER et al. relate to a URL login system for collecting objects from various locations on a network and bringing objects to a local client computer system where they are rendered, using a URL instead of a specific

home directory. BEER et al. disclose a simple translation rule to compute a URL from an e-mail address (see, for example, col.4, lines 5-30).

Further, Applicant submits that BEER et al. do not disclose a communicator which is connected to an Internet facsimile apparatus, since BEER et al. do not contain any disclosure with respect to an Internet facsimile apparatus.

It is further submitted that BEER et al. also do not disclose a controller which receives, from the Internet facsimile apparatus via the second communicator, an e-mail address of the recipient according to a SMTP protocol, since BEER et al. do not contain any disclosure with respect to a communication control apparatus connected to an Internet facsimile apparatus. Rather, in BEER et al., a user enters an e-mail address into a Login Manager 3, which runs on a user system 5, and the Login Manager 3 determines a URL corresponding to the e-mail (col. 3, lines 66-67 and col. 4, lines 1-2). On the other hand, the communication control apparatus of the present invention is distinct from an Internet facsimile apparatus.

Further, BEER et al. do not disclose a controller which receives, from the receiving Internet facsimile apparatus via the second communicator, e-mail data directed to the recipient according to the SMTP protocol, converts the received e-mail data into HTML data, and transmits, to the recipient via the first communicator, the converted HTML data, based on the converted URL data, according to a HTTP protocol.

Thus, Applicant submits that even if one attempted to combine the teachings of TADA and BEER et al. in the manner suggested by the Examiner, one would fail to arrive at the instant invention, as defined by newly submitted claims 7-8 and 11, as such a combination would fail to at least provide a communication control apparatus that is connected to an Internet facsimile apparatus and that receives, from the Internet facsimile apparatus via the second communicator, an e-mail address of the recipient according to a SMTP protocol.

Therefore, Applicant submits that the amended claims are not obvious in view of the applied art of record, and respectfully requests withdrawal of the 35 U.S.C. § 103 rejection, and an indication of allowability of claims 7-8 and 11. Newly submitted claims 7-8 and 11 are also submitted to be patentable over the Examiner's proposed combination, since the combination of TADA and BEER et al. does not disclose the combination of the features recited in Applicant's claims 7-8 and 11.

Moreover, Applicant submits that the Examiner has not set forth a proper motivation for combining TADA and BEER et al. In TADA, the Internet service provider 12 does not receive, from the user's e-mail service provider apparatus 16, which transmits e-mail to the Internet service provider 12, an e-mail address of the user terminal apparatus 14. Rather, in TADA, the Internet service provider 12 returns the e-mail HTML file to the user terminal apparatus 14, in response to a request from the user terminal apparatus 14 (col.5, lines 35-41). Similarly,

BEER et al. merely disclose a simple translation rule to compute a URL from an e-mail address.

With respect to the rejection of claim 3-4 and 6 under 35 U.S.C. § 103(a), Applicant submits that TADA does not disclose a communicator which is connected to a receiving Internet facsimile apparatus, the receiving Internet facsimile apparatus receiving, from a transmitter via the communication control apparatus, an e-mail to which image data is attached and printing the image data attached to the received e-mail, as Fig. 3 which illustrates the user terminal apparatus 14, does not describe an Internet facsimile apparatus.

As the Examiner admitted in the outstanding Official Action mailed on March 14, 2005, TADA also does not disclose a controller which receives, from the transmitter via the first communicator, URL data according to a HTTP protocol, and converts the received URL data into an e-mail address of the receiving Internet facsimile apparatus.

Further, Applicant submits that TADA merely discloses an Internet service provider 12 which receives e-mail from an e-mail service provider apparatus 16 (col.6, lines 9-11), converts the e-mail into HTML data (col.6, lines 11-13), and transmits an e-mail HTML file to a user terminal apparatus 14 (col.6, lines 38-41).

However, TADA does not disclose that the Internet service provider 12, which receives HTML, converts the HTML data into an e-mail, and transmits the e-mail. Thus, Applicant submits that TADA does not disclose a controller which receives, from the transmitter via the first communicator, HTML data according to

the HTTP protocol, converts the received HTML data into an e-mail data, and transmits, to the receiving Internet facsimile apparatus via the second communicator, the converted e-mail data, based on the converted e-mail address, according to a SMTP protocol.

Further, as discussed above, TADA does not contain any disclosure about receiving HTML, converting the HTML data into an e-mail, and transmitting the e-mail. Thus, Applicant submits that TADA can not receive, from the transmitter via the first communicator, URL data according to a HTTP protocol, and can not convert the received URL data into an e-mail address of the receiving Internet facsimile apparatus, as is taught by the present invention.

In view of the above, Applicant submits that the suggested combination of TADA and BEER et al. does not render the presently claimed invention obvious, and thus, respectfully requests that this 35 U.S.C. § 103 rejection be withdrawn.

Further, Applicant submits that MOCKAPETRIS fails to disclose that which is lacking in TADA. MOCKAPETRIS relates to RFE 1034-Domain names – concepts and facilities. However, MOCKAPETRIS merely provides a general explanation of Domain names.

MOCKAPETRIS does not disclose a communicator which is connected to an Internet facsimile apparatus (as taught by Applicant's invention), since MOCKAPETRIS merely discloses a general explanation of Domain names.

MOCKAPETRIS also does not disclose a controller which receives, from the transmitter via the first communicator, URL data according to a HTTP protocol, and converts the received URL data into an e-mail address of the

receiving Internet facsimile apparatus, since MOCKAPETRIS merely discloses a general explanation of Domain names.

Further, MOCKAPETRIS does not disclose a controller which receives, from the transmitter via the first communicator, HTML data according to the HTTP protocol, converts the received HTML data into an e-mail data, and transmits, to the receiving Internet facsimile apparatus via the second communicator, the converted e-mail data, based on the converted e-mail address, according to a SMTP protocol.

Thus, Applicant submits that even if one attempted to combine the teachings of TADA and MOCKAPETRIS in the manner suggested by the Examiner, one would fail to arrive at the instant invention, as defined by newly submitted claims 9-10 and 12, as such a combination would fail to at least provide a communication that receives, from the transmitter via the first communicator, URL data according to a HTTP protocol, converts the received URL data into an e-mail address of the receiving Internet facsimile apparatus, receives, from the transmitter via the first communicator, HTML data according to the HTTP protocol, converts the received HTML data into e-mail data, and transmits, to the receiving Internet facsimile apparatus via the second communicator, the converted e-mail data, based on the converted e-mail address, according to a SMTP protocol.

Therefore, Applicant submits that the amended claims are not obvious in view of the applied art of record, and respectfully request withdrawal of this 35 U.S.C. § 103 rejection, and an indication of allowability of claims 9-10 and 12.

Pending claims 9-10 and 12 are also submitted to be patentable over the Examiner's proposed combination, since the combination of TADA and MOCKAPETRIS does not disclose the combination of the features recited in Applicant's claims 9-10 and 12.

Moreover, the Examiner has failed to set forth a proper motivation for combining TADA and MOCKAPETRIS. In TADA, the Internet service provider 12 does not receive HTML data, does not convert the HTML data into an e-mail, and does not transmit the e-mail. Rather, in TADA, the Internet service provider 12 receives an e-mail, converts the e-mail into HTML data, and transmits the HTML. Thus, TADA is not supposed to receive URL data and to convert the URL data into an e-mail address. Further, MOCKAPETRIS merely discloses a general explanation of Domain names.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application in due course.

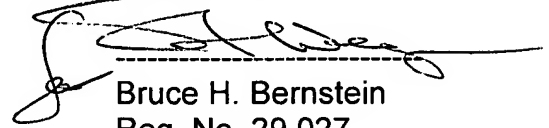
SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has canceled the rejected claims and has submitted new claims for consideration by the Examiner. With respect to the new claims, Applicant has pointed out the features thereof and has contrasted the features of the new claims with the disclosures of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Masao AKIMOTO

A handwritten signature in black ink, appearing to read 'Bruce H. Bernstein', is written over a horizontal dashed line.

Bruce H. Bernstein
Reg. No. 29,027

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Steven Wegman
Reg. No. 31,438